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10/764,400

01/23/2004

David Rex Gilliam

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EXAMINER

FRANTZ, JESSICA L

ART UNIT

PAPER NUMBER

3746

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|-----------|---------------|
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3 MONTHS

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                               |                                |  |
|------------------------------|-------------------------------|--------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/764,400 | Applicant(s)<br>GILLIAM ET AL. |  |
|                              | Examiner<br>Jessica L. Frantz | Art Unit<br>3746               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 and 36-38 is/are rejected.
- 7) ☒ Claim(s) 33-35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/23/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: On page 2 paragraph [0006], the specification refers to U.S. Patent 4,964,709 but it is believed this is the incorrect number as that particular patent refers to binoculars.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 8 recites the limitation "the resilient elastomeric grommet" in its first line. There is insufficient antecedent basis for this limitation in the claim.
4. Claim 29 recites the limitation "the means for attaching" in its first line. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 30 recites the limitation "the means for attaching" in its first line. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:  
  
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
7. Claims 1, 3-6, 10, 12-15, 19-28, 30, 32, and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim 6,336,794 in view of Mathis et al. 6,011,336.

Kim teaches the invention substantially as claimed including an outdoor cabinet 50, the cabinet 50 having a floor as shown in figure 1; a compressor 10 having a housing 11 with an upper housing section being the top portion of housing 11 where the connections 12 and 14 are shown and a lower housing section being the lower portion of housing 11 where it is attached to 30 and connections 13, 12, 14 to the unit further comprising a suction tube connection 13, a discharge tube connection 12 and an electrical connection 14; an offset mounting foot 30 having a main body being the central portion of 30 as shown in figure 2 with a top surface being the surface on which compressor 10 is mounted as shown in figure 1, an opposed bottom surface being the portion facing the cabinet 50 as shown in figure 1 and perimeter surface side walls extending between the top and bottom surfaces as shown in figure 1 creating a geometric shape, the compressor suction tube connection 13, discharge tube connection 12 and electrical connection 14 falling within a volume extending upward from the offset mounting foot as shown in figure 1, wherein the footprint provides the base area for the upwardly extending volume; means for damping 40 attached to the offset mounting foot 30 which are resilient and elastic see Kim column 3, lines 25-27 and contacting the cabinet floor; and means for assembling the compressor and the offset mounting foot together to form an assembly as discussed in column 3, lines 18-20. As shown in figure 2, the area at which the compressor 10 is mounted is offset towards the lower two appendages in order to align the geometric center of gravity with the geometric center of the supporting holes to effectively reduce vibration and noise see Kim column 3, lines 37-43. Kim also teaches the offset mounting foot 30 includes a

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plurality of appendages being the three points of the triangular mounting foot 30 as shown in figure 2 extending from the main body with perimeter surface segments forming a portion of the perimeter surface sidewalls extending between the appendages. Kim also teaches these appendages have top and bottom surfaces contiguous with the main body where the perimeter of the surface segments of the appendages and the sidewalls of the main body form a continuous outer perimeter see Kim figures 1 and 2. Kim further teaches the means for assembling the compressor to the offset mounting foot is through the use of welding see column 3, lines 18-20. Also, Kim teaches each appendage includes an aperture 31a, 31b, and 31c and each aperture is positioned at a predetermined location see figure 1 to correspond to a locating pin 41 in the floor of the cabinet 50 and the means for dampening 40 are assembled through the aperture 31a, 31b, and 31c in each appendage in the plurality of appendages as shown in figure 1. Kim also teaches a distal edge away from the main body of at least one appendage of the plurality of appendages has a bottom surface that lies between a plane that includes the bottom surface of the main body and a plane that includes the top surface of the distal edge of the appendage see Kim figure 1. Kim fails to teach the following claimed limitations that are taught by Mathis: as shown in figure 2, Mathis teaches the top surface 12 of the mount 10 includes a depression/concavity conforming to at least a portion of the compressor lower housing as shown in figure 2 for the purpose of reducing vibration see Mathis column 2, line 35. Mathis also teaches the footprint of the offset mounting foot 10 is substantially rectangular and formed of steel with a thickness of about .090 inches see Mathis column 2, lines 48-49 and

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column 3, lines 43-45. Mathis also teaches, the top surface 12 has a profile generally in the form of a concavity as shown in figure 2, where its low point is located at the center. As shown in Mathis figure 2, the top surface of the mount smoothly transitions from the low point (center) of the concavity to a high point (outer edges) toward the perimeter and appendages as shown in figure 2 and the concavity is completely accommodated within the main body as shown in figure 2. This structure is provided in order to correspond to the structure of the component it is to be supporting i.e. motor or compressor see Mathis column 2, lines 56-64. Mathis further teaches the offset mounting foot 10 includes a plurality of apertures 24, 26 and the means for assembling the compressor to the mount includes a plurality of threaded fasteners extending through the apertures for the purpose of securing the compressor/motor in place see Mathis column 2, lines 60-64. In regards to claims 4 and 13, the examiner takes Official Notice that the use of a threaded bolt and threaded nut with a washer is widely accepted throughout the mechanical arts as a method of fastening structures together see MPEP 2144.03. In regards to claims 21 and 22, while both Mathis and Kim fail to teach the geometric shape of the main body is either square or circular, it has been held that a change in shape is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed invention was significant see *In re Dailey* MPEP 2144.04 IV B. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the offset mounting foot of Kim with the depression/concavity of Mathis for the purpose of better supporting the compressor structure and reducing

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noise and vibration see Mathis column 2, lines 35-60 and a plurality of apertures where the means for assembling the compressor to the mount includes a plurality of threaded fasteners extending through the apertures for the purpose of securing the compressor/motor in place see Mathis column 2, lines 60-64.

8. Claims 2, 11 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim 6,336,794 in view of Mathis et al. 6,011,336 and further in view of Dreiman et al. 6,092,284. Kim in view of Mathis teaches the claimed invention as discussed above but fails to teach the following claimed limitations that are taught by Dreiman: a plurality of bosses 68 which are used to facilitate welding as discussed in the Abstract lines 17-20 and column 6, lines 20-29. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Kim in view of Mathis with the bosses of Dreiman in order to facilitate welding see Dreiman Abstract lines 17-20 and column 6, lines 20-29.

9. Claims 7-9, 16-18 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim 6,336,794 in view of Mathis et al. 6,011,336 and further in view of Richardson, Jr. 4,946,351. Kim in view of Mathis teaches the claimed invention as discussed above but fails to teach the following claimed limitations that are taught by Richardson: the means for dampening are grommets 88 and they are used for the purpose of securing the mounting device to the cabinet as discussed in Richardson column 5, lines 25-28. Richardson also teaches the offset mounting foot further includes an aperture/bore 86 extending between the top surface being the top of plate 84 and the bottom surface being the bottom of grommet 88, the aperture sized so that

the compressor's housing when assembled to the offset mounting foot does not extend below the bottom surface of the mounting foot for the purpose of securing the compressor device see Richardson column 5, lines 17-33. In regards to claims 8 and 17, it has been held obvious to select a known material based on its suitability for its intended use see *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) MPEP 2144.07. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Kim in view of Mathis to include the grommets of Richardson for the purpose of securing the mounting device to the cabinet see Richardson column 5, lines 25-28 and the aperture/bore of Richardson in order to secure the compressor device see Richardson column 5, lines 17-33.

***Allowable Subject Matter***

10. Claims 33-35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica L. Frantz whose telephone number is 571-272-5822. The examiner can normally be reached on Monday through Friday 8:30a.m.-5:00p.m. E.S.T..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on (571) 272-4828. The fax phone

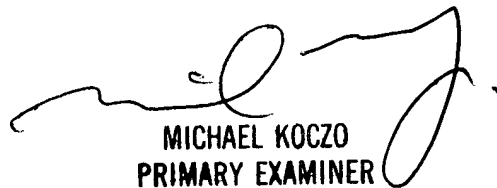


number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Jessica Franz*

JF 1/25/2007

  
MICHAEL KOCZO  
PRIMARY EXAMINER  
*Au 3746*